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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,372	07/27/2001	Precti G. Lal	PC-0050 US	1477

7590 02/05/2003

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EXAMINER
O HARA, EILEEN B

ART UNIT	PAPER NUMBER
1646	5

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/917,372	LAL ET AL.	
	Examiner	Art Unit	
	Eileen B. O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to polynucletoides, vectors, host cells and recombinant method of producing protein , classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.

II. Claims 8-11, in so far as they are drawn to a method for detecting expression or differential expression of nucleic acids in a sample, classified in class 435, subclass 6.

III. Claims 12 and 13, drawn to a method of using cDNA to screen a plurality of molecules or compounds to identify a molecule or compound that specifically binds, classified in class 435, subclass 6, for example.

IV. Claims 14, 15 and 22, drawn to polypeptides, classified in class 530, subclass 350, for example.

V. Claims 16 and 17, drawn to a method of using a protein to screen compounds to identify a ligand, classified in class 435, subclass 7.1, for example.

VI. Claims 18 and 19, drawn to antibodies and methods of making antibodies and method of purifying antibodies, classified in class 530, subclass 388.22, for example.

VII. Claims 20 and 21, drawn to a method for using antibody to diagnose conditions or diseases associated with increased expression of the protein of Group IV by

detecting expression of protein in a sample, classified in class 435, subclass 7.1, for example.

VIII. Claim 22, drawn to a method of treating rheumatoid arthritis comprising administering a polypeptide of Group IV.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct inventions because they are physically and functionally distinct chemical entities having different structures and functions, and the protein products can be made by another materially different process, such as by synthesis or purification from the natural source. Further, the polynucleotides may be used for processes other than the production of proteins, such as nucleic acid hybridization assays and gene therapy.

Inventions IV and VI are also unrelated. The polypeptides and antibodies are distinct inventions because they are physically and functionally distinct chemical entities having different structures and functions, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the protein.

Invention I is related to each of Inventions II, III and V as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be

used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cDNAs can be used in a method of detecting the expression of a nucleic acid molecule in a sample by hybridization, or in a method of screening a plurality of compounds to identify a molecule for compound that specifically binds to the cDNA, or in a method of identifying a compound that binds to a polypeptide (by expressing the nucleic acid in a cell to produce the polypeptide used in the assay), all of which are materially different methods that have different starting compounds, method steps and goals.

Invention IV and each of inventions V and VIII are also related as product and process of use. In the instant case, the polypeptides can be used in a method for identifying a compound which binds to a polypeptide, but the polypeptides may also be used in a method of treatment, which is a materially different method.

Inventions VI and VII are also related as product and process of use. In the instant case, the antibodies can be used in a method of detecting protein in a sample to diagnose a disease, but the antibodies can also be used in a method of treatment, which is a materially different method.

Inventions I and each of inventions VI, VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the cDNAs and antibodies are distinct inventions because they are structurally and functionally distinct chemical compounds, and the cDNAs are not used or defined in the method of detecting protein in a sample or the method of treatment with the protein.

Invention IV is unrelated to each of inventions II, III and VII. The polypeptides are not used in the methods of detecting nucleic acids or using nucleic acids to

screen for molecules that bind the nucleic acids, or in the method of diagnosis by detecting protein by antibody binding.

Invention VI is unrelated to each of inventions II, III, V and VIII. The antibodies are not used in the methods of detecting nucleic acids or using nucleic acids to screen for molecules that bind the nucleic acids or in the method of screening for compounds that may be a ligand for the polypeptide or in the method of treatment with the polypeptide.

Inventions II, III, V, VII and VIII are also not related to each other. The methods of the different inventions require different starting compounds and have different steps and goals.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, separate search requirements and/or divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600